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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,137	01/18/2001	Lloyd Adams	JPM-052	7821
7590 08/08/2008 Intellectual Property Department Goodwin/Procter LLP 901 New York Avenue, NW Washington, DC 20001			EXAMINER KAZMI, HANI M	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 08/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/765,137

Applicant(s)

ADAMS ET AL.

Examiner

Hani Kazimi

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on February 08, 2008. Claims 1-20 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson (US 5,699,527) in view of Norris (US 5,870,721).

Claims 1-6, 14-19, Davidson teaches a system and corresponding method for producing and sending a loan document to a customer, the system comprising, a web-enabled customer interface which receives loan information from the customer (col. 5, lines 2-12), a network coupled to the customer interface, the network receives the loan information from the customer interface (col. 5, lines 23-39), a web site coupled to the network, the web site receives the loan information and merges the loan information with a loan application form to produce a loan application (col. 6, lines 20-39), a loan processor coupled to the web site, the loan processor receives the loan application, performs a credit check on the customer based on the loan application (col. 4, lines 33-38; col. 5, lines 37-39); and a document server coupled to the loan processor, the document server generates and sends the loan document to the customer, based on the loan application, when the loan processor determines that the customer should receive the loan, the loan processor sends the loan document to the customer through one of e-mail, facsimile, the network, a first printer coupled to the network, and a second printer coupled to another network (col. 7, lines 6-11)

Davidson does not explicitly teach that the loan processor determines whether the customer should receive a loan based on the credit check. Norris teaches a loan approval determination based on credit check; and generating and sending loan agreement and related documentation to the customer via facsimile (abstract, col. 2, lines 13-15 and 35-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Davidson to include these features as taught by

Norris for the obvious reason of ensuring that the applicant is credit worthy and for speedy transmittal of all related and necessary documents between the lender and customer.

Claims 7-13 and 20; Davidson and Norris teach all the claimed limitations as discussed above with respect to claims 1-6 and 14-19. Davidson and Norris do not explicitly teach that cashing a check indicates acceptance by the customer of the terms listed in the loan document, checking the validity of the check and verifying the customer account by sending a test transaction.

Official notice is hereby taken that the steps of cashing a check to indicate acceptance by the customer of the terms listed in the loan document, checking the validity of the check and verifying the customer account by sending a test transaction are old and well known.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Davidson to include these features. One would have been motivated to do so in order to allow the customer to accept the loan by cashing the check. Verifying the customer account allows the lender to ensure that the account to which money is deposited actually belongs to the customer, thereby preventing fraud or error.

Response to Arguments

3. Applicant's arguments filed 2/8/2008 have been fully considered but they are not persuasive.

Applicant argues that Davidson fails to teach a website, hosted by a system (items (1) and (2) from applicant's remarks). Examiner respectfully disagrees. Davidson explicitly teaches that the applicant's computer may be directly connected to the lending institution via a modem (col. 5, lines 24-26; col. 6, lines 6-8, fig. 3D RN {31} "*Personal data and signature data is collected (if possible) and saved into the bank computer*"). Furthermore, Davidson teaches "remote site" having a mechanism for facilitating electronic communication with a processing device at the lending institution (col. 11, lines 13-19).

Regarding item (4), Applicant argues that Davidson fails to disclose that the system generates loan documents and sends them to the customer. Examiner respectfully disagrees. Davidson teaches that all the documents required to formalize the loan is printed and reviewed by parties and signed and dated (col. 7, lines 6-11).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is to ensure that the applicant is credit worthy and for speedy transmittal of all related and necessary documents between the lender and customer

Conclusion

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691